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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: BUTTAU et al.

Serial No.: 10/536,957

Filed: 5/31/2005

Title: TOOL HOLDING DEVICE AND  
METHOD FOR POSITIONING A TOOL

Atty. Dkt.: 49-004-TN

Art Unit: 3722

Examiner: Dana ROSS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Date: 16 July 2007

## CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence (four (4) pages) is being facsimile transmitted to the USPTO (Fax. No. 571-273-8300) on 16 July 2007. Typed Name: Cynthia K. Nicholson.

Signature: RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Restriction Requirement mailed on June 18, 2007 in connection with the above application, Applicants hereby provisionally elect Group I of claims 1-9, drawn to a tool holding device, with traverse. However, for reasons including those provided below, the applicants respectfully request that the restriction requirement be withdrawn, and that the claims be examined together in the present application.

Traverse

As stated in the MPEP, "when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office under 35 USC 371, PCT Rule 13.1

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and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 USC 111." MPEP 1850 (emphasis added). Examiners should permit claims the same application where there is a unity of invention. MPEP 1850 (II). There is a unity of invention "when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression 'special technical features' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." PCT Rule 13.2. PCT Rule 13 is construed by the USPTO as expressly permitting a combination of an independent claim for a given process and an independent claim for an apparatus or means specifically designed for carrying out the process. MPEP 1850 (III)(A).

In the office action, the examiner expressly references the practice for national applications filed under 35 USC 111, i.e., MPEP 806.05(h). That is the incorrect standard to apply to the present application, which is a national phase of a PCT application. MPEP 801 (chapter 800 of the MPEP is limited to restriction requirements in applications under 35 USC 111; unity of invention of applications entering the national stage under the PCT is discussed in MPEP 1800). Furthermore, the Restriction Requirement improperly relies on the product/process distinction and possible different classification as providing a reason for the restriction requirement. The product/process test and classification test set out in MPEP 806.05 are completely improper with respect to national phase applications under the PCT.

In the instant application, since the claimed inventions all involve the same or corresponding special technical features, there is unity of the invention, and restriction in this application is not proper. The following are examples of why there is unity of invention.

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Claim 1 (of Group I) recites: “[a] tool-holding device for holding a tool on a tool chuck, having a tool-locating region for at least partly locating the tool, a connecting region for arranging on the tool chuck, and a positioning opening, through which a positioning means can be placed against the tool arranged at least partly in the tool-locating region.”

Claim 10 (of Group II) recites: “[a] method of positioning a tool in a tool chuck, in which a tool-holding device is arranged on the tool chuck and the tool is held by the tool-holding device, and a characteristic element of the tool is scanned for positioning a positioning means, a force being applied to the tool by the positioning means through a positioning opening in the tool-holding device.”

The invention, as currently recited in independent claims 1 and 10, is focused on a tool holding device (e.g., 22, 50, 58) and a method for positioning a tool (24). The tool holding device is a special construction to ensure a correct and efficient positioning of the tool, wherein the positioning is carried out before the tool is machined. The tool holding device has a specialized shape of its tool fitting, which is selectively matching to a tool shaft of the tool. A positioning of the tool in a tool chuck (20) without the tool holding device is not possible due to an incompatibility of a tool fitting of the tool chuck with respect to the shaft of the tool. The tool chuck works along the lines of a shrink fit; that is, the diameter of the locating opening (28) of the tool chuck is smaller in size than the diameter of the tool's shaft. A fitting of these two components is only possible during a shrinking and preparation process, respectively, which results in a stable connection between the tool and the tool chuck. Therefore, it is not possible to position the tool before the final assembly by positioning or inserting the tool's shaft in the tool fitting of the tool chuck. Rather, an assistive structure is needed, namely, the tool holding device.

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The method used for the positioning of the tool directly depends on the usage of this specialized tool holding device. Therefore, the tool holding device and the method for positioning a tool are inventions which are connected to one another and which are exclusively and only useable with one another.

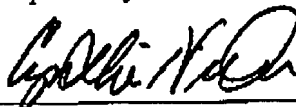
Consequently, there is a technical relationship among these recited inventions involving corresponding special technical features. The tool holding device and the method for positioning a tool have a single general inventive concept. Thus, these claims share the general invention concept so as to have a unity of invention.

Furthermore, independent claim 1 is directed to an apparatus specifically designed for carrying out the process of claim 10. Under MPEP 1850 (III)(A), independent claims 1 and 10 are considered to have a unity of invention, such that restriction is improper.

In summary, the restriction requirement should be withdrawn because there is unity of the invention under PCT Rule 13.2. An additional reason that the restriction requirement should be withdrawn is that the basis provided in the restriction requirement is improper with respect to the present application, which is a national phase of a PCT application.

Examination of the present application in view of the above provisional election with traverse is respectfully requested. Please charge any necessary fees to Deposit Account 50-1147.

Respectfully submitted,



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